

Appl. No.: 09/458,602
Amdt. Dated 01/18/2007
Reply to Office Action of 10/19/2006

REMARKS

This response is submitted in reply to the outstanding Office Action dated October 19, 2006. Claims 1-15 currently stand rejected and are the only pending claims in the present application. Applicants respectfully traverse.

In light of the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present invention.

Claim Rejections - 35 USC §103

Claims 1-2, 7, 9 and 11-14

Claims 1-2, 7, 9 and 11-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang et al. (U.S. Patent No. 6,253,327, hereinafter, “Zhang”) in view of Bartoli et al. (U.S. Patent No. 6,047,268, hereinafter “Bartoli”) and further in view of Teare et al. (U.S. Patent No. 5,243,652, hereinafter “Teare”). Applicants respectfully note that claim 2 has previously been canceled, without prejudice, and thus the rejection of claim 2 is moot. With respect to the rejections of claims 1, 7, 9 and 11-14, Applicants respectfully traverse.

A. The Office Action fails to establish *prima facie* obviousness with respect to the claimed invention

Although the requirements for a *prima facie* case of obviousness are well known to the Examiner, they are stated here for convenience and for completeness of the record for appeal. First, there must be some suggestion or motivation to modify the reference or to combine the reference teaching. Second, there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations. However, in the present rejections, the Office Action has at least failed to even assert that all the claimed elements in independent claims 1 and 9 are taught or suggested in a prior art reference and thus, the current rejections are improper in view of MPEP 706.02(j) citing the patent laws.

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Specifically, Applicants previously amended independent claims 1 and 9 to recite, *inter alia*, identifying an attribute comprising an indication of the location from which the request was received based upon a packet received by the gateway device and determining if the user is entitled to access the destination network based upon the user profile and the attribute comprising the indication of the location from which the request was received.

The Office Action cites Zhang as disclosing determining if the user is entitled to access the destination network based upon the user profile at col. 7, lines 12-17. The Office Action also asserts that Teare discloses a system where the attribute comprises an indication of the location from which the request was received at col. 3, lines 4-18. However, even if one were to assume for the sake of argument that the assertions above which have been made in the Office Action are true (an assumption with which Applicants expressly disagree), the Office Action still fails to even allege that any reference teaches or suggests determining if the user is entitled to access the destination network based upon the attribute comprising the indication of the location from which the request was received. Thus, a *prima facie* case of obviousness has not been established as required in accordance with MPEP 706.02(j) citing the patent laws. Therefore, the rejections of independent claims 1 and 9 are traversed.

In addition to the fact that the Office Action fails to even allege that any reference teaches or suggest determining if the user is entitled to access the destination network based upon the attribute comprising the indication of the location from which the request was received as recited in independent claims 1 and 9, Applicants submit that, in any case, each of the cited references fails to disclose the above-recited feature.

B. The cited references fail to teach or suggest the claimed invention

Even if one assumes that a *prima facie* case of obviousness was properly alleged by the Office Action, Applicants still submit that the combination of the cited references fails to meet the claimed invention as recited in independent claims 1 and 9. As stated above, Applicants have amended independent claims 1 and 9 to recite, *inter alia*, identifying an attribute comprising an indication of the location from which the request was received based upon a packet received by the gateway device and accessing a user profile based on the attribute.

Zhang is directed to a single step network logon. The Office Action admits that Zhang fails to teach or suggest identifying an attribute comprising an indication of the location from which the request was received based upon a packet received by the gateway device as recited in independent claims 1 and 9. Bartoli is directed to allowing authentication transactions to be performed via use of "cookies" to permit a user to conduct follow-on transactions without further installation of special software on the user's client terminal. Bartoli also fails to teach or suggest the above recited features and is not cited as such. Accordingly, the Office Action cites Teare as disclosing the feature recited above at col. 3, lines 4-18.

Teare is directed to a system whereby a mobile node having encrypted material may receive an access key for decrypting the material in response to a match between the position history of the mobile node and acceptable position history data maintained at a central facility. In other words, according to Teare, a key to grant access to data already stored at the mobile node may be granted in response to location information. However, the claimed invention grants access to a network based on location information. Thus, Teare fails to teach or suggest identifying an attribute comprising an indication of the location from which the request was received based upon a packet received by the gateway device as recited in independent claims 1 and 9.

Since Zhang, Bartoli and Teare each fail to teach or suggest the same aforementioned features of independent claims 1 and 9, any combination of Zhang, Bartoli and Teare also fails to teach or suggest the subject matter of independent claims 1 and 9. Thus, Zhang, Bartoli and Teare, taken either individually or in combination, do not anticipate, or render independent claims 1 and 9 obvious. Claims 7 and 11-14 depend either directly or indirectly from a respective one of independent claims 1 and 9, and as such, include all the recitations of their respective independent claims. The dependent claims 7 and 11-14 are therefore patentably distinct from Zhang and Bartoli, individually or in combination, for at least the same reasons as given above for independent claims 1 and 9.

Accordingly, Applicants respectfully submit that the rejection of claims 1, 7, 9 and 11-14 as being unpatentable over Zhang in view of Bartoli and further in view of Teare, is overcome.

C. Bartoli and Teare are not proper references

Applicants continue to submit that Bartoli is not a proper reference since Bartoli is non-analogous art. However, Applicants will not repeat the previously presented arguments in this regard.

Regardless of whether Bartoli is a proper reference, however, Applicants also respectfully note that Teare is not analogous art. The claimed invention is generally directed to a method and system for providing authorizing, authentication and accounting to users having transparent access to a destination network. To rely on a reference under 35 U.S.C. §103, it must be analogous prior art. See MPEP 2141.01(a). The two-part test for analogous art requires that “the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *State Contracting & Eng’g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed.Cir. 2003) (where if the general scope of a reference is outside the pertinent field of endeavor, the reference may still be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). Teare is directed to granting access to data already stored at a mobile node in response to location history. The problem to be addressed in this art is to protect data (e.g., encrypted material) stored locally at the mobile node (see FIG. 1 of Teare). To the contrary, the claimed invention is directed to providing authorizing, authentication and accounting for transparent access to a network via a gateway device. The problem to be addressed in the art of the claimed invention is developing a way to enable users to access a network, not information stored locally. Teare, on the one hand, and the present application, on the other hand, are simply not in the same field of endeavor with Teare being concerned about accessing locally stored information while the claimed invention is, quite differently, directed to providing network access. Teare is not interested in granting access to a network, but rather simply how to provide security for locally stored information. There would be no reason for one skilled in the art faced with the problem of providing authorizing, authentication and accounting for transparent access to a network to consider accessing locally stored information pertinent. Therefore, Teare is also not reasonably pertinent to the particular

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problem with which the inventor was concerned. Thus, Teare is not analogous art and, therefore, cannot be relied upon to support an obviousness rejection under 35 U.S.C. §103.

Furthermore, Applicants submit that there is no motivation to combine the references. In this regard, a teaching or motivation to combine the references is essential in order to properly combine references. *In re Fine*, 337 F.2d 1071, 1075 (Fed. Cir. 1988). In fact, the Court of Appeals for the Federal Circuit has stated that, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Although the evidence of a suggestion, teaching, or motivation to combine the references commonly comes from the prior art references themselves, the suggestion, teaching, or motivation can come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved. *Id.* In any event, **the showing must be clear and particular** and “[b]road conclusory statements regarding the teaching effect of multiple references, standing alone, are not ‘evidence’.” *Id.* The Office Action states that one having ordinary skill in the art would have been motivated to combine Zhang and Teare “because mobile devices provide limited control over transmission (column 1 lines 10-20) and mobile devices are becoming more common.” However, the Applicants seasonably challenge this assertion as being a broad conclusory statement which, standing alone, is not “evidence”, as required under the patent laws, of motivation to combine the cited references. Such a broad statement does not provide evidence of motivation for one seeking to provide authorizing, authentication and accounting for transparent access to a network to look to the art of accessing locally stored information. Additionally, the statement above, even if assumed true does not appear to have any relationship to providing authorizing, authentication and accounting for transparent access to a network as provided by the claimed invention. Accordingly, Applicants respectfully submit that there is no motivation to combine the references.

Since the Teare reference cannot properly be combined with the Zhang or Bartoli references, it is respectfully submitted that the rejections of all claims based on the combination of these references is overcome.

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Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 1, 7, 9 and 11-14 are overcome.

Claims 3-6, 8 and 15

Claims 3-6, 8 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zhang in view of Bartoli and Teare, and further in view of Lim et al. (U.S. Patent No. 6,434,619, hereinafter “Lim”).

As stated above, neither Zhang, Bartoli nor Teare teaches or suggests identifying an attribute comprising an indication of the location from which the request was received based upon a packet received by the gateway device as recited in independent claims 1 and 9. Lim also fails to teach or suggest such features and is not cited as such. Since Zhang, Bartoli, Teare and Lim each fail to teach or suggest the aforementioned features of independent claims 1 and 9, any combination of Zhang, Bartoli, Teare and Lim also fails to teach or suggest the subject matter of independent claims 1 and 9. Thus, Zhang, Bartoli, Teare and Lim, taken either individually or in combination, do not anticipate, or render independent claims 1 and 9 obvious. Claims 3-6, 8 and 15 depend either directly or indirectly from a respective one of independent claims 1 and 9, and as such, include all the recitations of their respective independent claims. The dependent claims 3-6, 8 and 15 are therefore patentably distinct from Zhang, Bartoli, Teare and Lim, individually or in combination, for at least the same reasons as given above for independent claims 1 and 9.

Accordingly, Applicants respectfully submit that the rejections of dependent claims 3-6, 8 and 15 as being unpatentable over Zhang in view of Bartoli and Teare, and further in view of Lim, are overcome.

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CONCLUSION

In view of the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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